

## **REMARKS/ARGUMENTS**

Claims 1-28 were examined on the merits. Claims 1, 8, 15, and 19 remain independent claims. The amendment above introduces no new matters.

### **35 USC 103(a) Rejection**

Claims 1-20, 25-28 were rejected under 35 U.S.C. § 103(a) as being obvious over Browne (WO 92/22983) in view of Salmonsen (U.S. Patent No. 4,891,476) in view of Boyle (U.S. Patent 6,453,115) in view of Utsunomiya et al. (U.S. Patent App. Pub. 2002/0066113). The applicant respectfully disagrees for the reasons discussed below. The applicant also hereby makes amendments to the claims in view of the Examiner's comments. Applicant respectfully submits that the amendments to the claims traverse this rejection.

The 35 U.S.C. §103(a) states the following:

“(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.”

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

### **The Cited References, Combined or Individually, Do Not Disclose Every Limitation**

The amended claim 1 recites the following limitations:

“A system useful for storing a television program P, comprising:  
a PVR having a housing, a first memory, a network interface device, and logic configured to copy at least a first portion of the television program P into

said first memory, wherein said first memory and said network interface device are disposed within said housing;

a network communicatively connected to said network interface device and to a plurality of devices external to said housing;

a personal computer connected to the network;

a second memory disposed outside of said housing and is in communication with the PVR via the network interface device;

virtual storage management (VSM) logic configured to track the location of the second memory on the network, and to store a second portion of the program P in the second memory; and

wherein said plurality of devices external to said housing includes said personal computer and said second memory.“

Without conceding the propriety of the asserted combination, however, Applicant respectfully submits that the asserted combination does not disclose at least the aforementioned features of claim 1, for at least the following reason.

The cited reference does not disclose **a second memory disposed outside the housing of the PVR and coupled to the PVR via a network.**

Browne discusses an arrangement that includes a second memory 104b. (Fig. 1, page 10, lines 32 – page 11, line11). This second memory, however, is physically located within the PVR of Browne. In other words, Browne fails to disclose a second memory disposed outside the housing of the PVR, and external to the PVR.

The Office admitted on page 3 of the Office Action that Browne fails to disclose any type of VSM. Without a VSM, the Browne device would not be able to access portions of a program saved on an “external” second memory. Base on this, Browne’s optional storage section 104b can only refer to a storage device that is housed within the PVR.

Furthermore, without a VSM, the Browne device would not be able to store different portions of program P at different memories as claimed. Base on this, Browne’s optional storage section 104b can only refer to a storage drive such as a CD-ROM, similar to the archival system recited in the applicant’s later claims.

Additionally, Browne fails to disclose a network as claimed. The amended claim 1 now distinguishes from Browne, by requiring a network that allows external devices to be connected to the PVR. No such network is found in Browne.

Again, Browne discloses a standalone PVR with extra storage space within the PVR. Browne does not disclose having additional external storage devices attached to the PVR. Amended claim 1 requires the second memory to be an external storage device attached to the PVR via a network.

As for Salmonsen, the Office contends that Salmonsen discloses remote storage 1444 to “save” television programs. A review of Salmonsen reveals, however, that the “remote storage 144” is merely a source of media content, and not a destination to save media content (please see paragraph [0183]). Salmonsen is about a system that allows viewing of all types of media contents from various sources (including from a remote storage 144), even when the viewing system does not support the various formats of media contents. Salmonsen has nothing to do with saving or storing television programs, let alone saving portions of a program in separate memory devices as claimed.

Further, because Salmonsen is a viewing system offering solutions in viewing contents of incompatible formats, and not a recording system for saving contents, it is considered non-analogous art, and thus cannot be combined with Browne to form the rejection.

As for Boyle, the Office contends that Boyle discloses a PVR with two memory devices, and a VSM to manage multiple memory locations. A review of Boyle reveals, however, that Boyle merely discloses a hard drive with one or more magnetic discs, all within the same housing. Boyle fails to disclose an external second memory as claimed. Also, Boyle fails to disclose any type of VSM. The portion of text (col. 6, lines 38-58; col. 10, lines 31-42, col. 13, line 50-58) the Office pointed out merely relate to accessing particular frames of a video using TrickPlay. Trickplay is not related to retrieving and playing back portions of the same television program stored in different memory locations.

Lastly, regarding Utsunomiya, the Office contends that Utsunomiya teaches storing a portion of the program P in the second memory. The Applicant respectfully disagrees.

Utsunomiya teaches a plurality of players connected to a network, and having a program to organize sequential playing of these players. In other words, Utsunomiya has a program that tells when each player is to play a file. Referring to paragraphs [0043], [0077], [0080], [0092-0094] of Utsunomiya, both players 3 and 4, each has a disk 18 for recording and playing. A content that is recorded in both players 3 and 4 are played by players 3 and 4 in an almost-continuous manner by having sequential playing instructions for players 3 and 4. In the claimed subject matter, however, the second portion is not played at the second memory, rather, the second portion is retrieved from the remote second memory external to the PVR, and then played by the PVR. Therefore, Utsunomiya fails to disclose a second memory as claimed.

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claim 1 under 35 U.S.C. § 103 are respectfully requested.

Accordingly, the currently amended claim 1 is patentable over the cited references. Thus, dependent claims 2-7, 25 depending thereupon are also patentable.

### **The Basis for Combining Prior Art is Insufficient**

The Examiner's basis for combining the four references is that the four references each mentions parts of the claimed elements. Such a broad generality is not sufficient, and is considered piecemeal-type argument. Further consideration is respectfully requested.

Upon further examination, the four references solve different problems, and none of the cited references is about saving a second portion of the same program in a second memory external the PVR, for playing at the PVR.

KSR International Co. v. Teleflex Inc. (ISR) requires that an Examiner provide "some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness." (KSR Opinion at p. 14). An Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does," (KSR Opinion at p. 15). And, the Examiner must make "'explicit' this rationale of 'the apparent reason to combine the known elements in the fashion claimed,'"

including a detailed explanation of "the effects of demands known to the design community or present in the marketplace" and "'the background knowledge possessed by a person having ordinary skill in the art." (KSR Opinion at p. 14). Anything less than such an explicit analysis is not sufficient to support a *prima facie* case of obviousness. "Based upon KSR International Co. v. Teleflex Inc. the Examiner has failed to show any sufficient reason for combining the references, and therefore the claims are not obvious in view of any combination of the cited references."

### **Patent Examiners Should Interpret Claims in Light of Specification**

The court has recently indicated that the PTO should apply the principles of *Phillips v. AWH* during prosecution — rather than the PTO's current practice of giving claims their "broadest reasonable interpretation." *In re Johnston* (Fed. Cir. 2006). The Patent Office may use a dictionary in defining the patent applicant's claim terms only when the patent specification did not otherwise provide any interpretation.

### **Non-Analogous Art**

Further, the four cited references are non-analogous art due to its fundamental difference in solving different types of needs. While some are directed at viewing contents of different formats, others are for saving contents. Specifically, the Salmons reference involves different problems and different solutions.

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte*

America, Inc., 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved). MPEP 2141.01(a).

### **Rejection to Claim 5**

Claim 5 requires an archival storage device in addition to the second memory. The Office contends that Browne's removable media for long term storage satisfies both claimed elements. The applicant respectfully disagrees. As discussed above, Browne's removable media is different from the claimed second memory, and a single feature from the cited reference cannot be used to account for two different claimed elements.

Accordingly, for at least the aforementioned reasons, reconsideration and withdrawal of the rejection of claim 5 under 35 U.S.C. § 103 is respectfully requested.

### **Rejection to Claim 7**

Claim 7 now requires that both the first and the second portion are retrieved to the PVR for playback. As discussed above, none of the cited prior art teaches this. Utsunomiya merely teaches multiple players playing consecutively.

Accordingly, for at least the aforementioned reasons, reconsideration and withdrawal of the rejection of claim 7 under 35 U.S.C. § 103 is respectfully requested.

### **Rejection to Claims 8-14**

Arguments to claims 8-14 are similar to that of claims 1-7 and are applied here, some arguments are repeated hereafter.

#### **The Cited References, Combined or Individually, Do Not Disclose Every Limitation**

The amended claim 8 recites the following limitations:

“A system useful for storing a television program P, comprising:  
a PVR having a housing, a first memory, a network interface device, and means  
for copying at least a first portion of the television program P into said first memory,

wherein said first memory and said network interface device are disposed within said housing;

a network communicatively connected to said network interface device and to other devices external to said housing;

a personal computer connected to the network;

a second memory disposed external to said housing and is in communication with the PVR via the network interface device;

virtual storage management (VSM) means for tracking the location of the second memory on the network, and storing a second portion of the program P in the second memory;

wherein the VSM means is configured as part of the PVR to track one or more logical addresses of the second memory on the network for storing a plurality of portions of the program P including said portion; and

wherein said other devices external to said housing includes said personal computer and said second memory.”

Without conceding the propriety of the asserted combination, however, Applicant respectfully submits that the asserted combination does not disclose at least the aforementioned feature of claim 8, for at least the following reason.

The cited reference does not disclose **a second memory disposed external to the PVR and coupled to the PVR via a network.**

Again, Browne discloses a standalone PVR with extra storage space within the PVR.

Browne does not disclose having additional external storage devices attached to the PVR.

Amended claim 8 requires the second memory to be an external storage device attached to the PVR.

As for Salmonsen, the Office contends that Salmonsen discloses remote storage 1444 to save television programs. A review of Salmonsen reveals, however, that the “remote storage 144” is merely a source of media content, and not a destination to storage media content (please see paragraph [0183]). Salmonsen is about a system that allows viewing of all types of media contents from various sources, when the viewing system does not support the various formats. Salmonsen has nothing to do with saving or storing television programs, let alone saving portions of a programs in separate memory devices as claimed.

Further, because Salmonsen is a viewing system, and not a recording system, it is considered non-analogous art, and thus cannot be combined with Browne to form the rejection.

As for Boyle, the Office contends that Boyle discloses a PVR with two memory devices, and a VSM to manage multiple memory locations. A review of Boyle reveals, however, that Boyle merely discloses a hard drive with one or more magnetic discs. Boyle fails to disclose an external second memory as claimed. Also, Boyle fails to disclose any type of VSM. The portion of text (col. 6, lines 38-58; col. 10, lines 31-42, col. 13, line 50-58) the Office pointed out merely relates to accessing particular frames of a video using TrickPlay. Trickplay is not related to retrieving and playing back portions of the same television program stored in different memory locations.

Lastly, regarding Utsunomiya, the Office contends that Utsunomiya teaches storing a portion of the program P in the second memory.

Utsunomiya teaches a plurality of players connected to a network, and having a program to organize sequential playing of these players. Referring to paragraphs [0043], [0077], [0080], [0092-0094] of Utsunomiya, both players 3 and 4, each has a disk 18 for recording and playing. A content that is recorded in both players 3 and 4 are played by players 3 and 4 in an almost-continuous manner by having sequential playing instructions for players 3 and 4. In the claimed subject matter, however, the second portion is retrieved from the remote second memory external to the PVR, and then played by the PVR. Therefore, Utsunomiya fails to disclose a second memory as claimed.

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claim 8 under 35 U.S.C. § 103 are respectfully requested.

Accordingly, the currently amended claim 8 is patentable over the cited references. Thus, dependent claims 9-14, 26 depending thereupon are also patentable.

### **Rejection to Claim 12**

Claim 12 requires an archival storage device in addition to the second memory. The Office contends that Browne's removable media for long term storage satisfies both claimed

elements. The applicant respectfully disagrees. As discussed above, Browne's removable media is different from the claimed second memory, and a single feature cannot be used to account for two different claimed elements.

Accordingly, for at least the aforementioned reasons, reconsideration and withdrawal of the rejection of claim 12 under 35 U.S.C. § 103 is respectfully requested.

### **Rejection to Claim 14**

Claim 14 now requires that both the first and the second portion are retrieved to the PVR for playback. As discussed above, none of the cited prior art teaches this. Utsunomiya merely teaches multiple players playing consecutively.

Accordingly, for at least the aforementioned reasons, reconsideration and withdrawal of the rejection of claim 14 under 35 U.S.C. § 103 is respectfully requested.

### **Rejection to Claims 15-20**

Arguments to claims 15-20 are similar to that of claims 1-7 and are applied here, some arguments are repeated hereafter.

#### **The Cited References, Combined or Individually, Do Not Disclose Every Limitation**

The amended claim 15 recites the following limitations:

“A method of storing a television program P ~~using a PVR having a first memory device~~, the method comprising:

providing a PVR having a first memory device, and a virtual storage management (VSM) logic;

providing a network communicatively connected to a personal computer, the PVR, a second memory device, wherein both the personal computer and the second memory device are remotely attached to the PVR via the network;

identifying [[a]]~~the remotely attached~~ second memory device that is not full on the network in communication with the PVR;

storing at least a portion of the ~~program~~ program P in the second memory device; and

using the VSM logic of the PVR to track one or more logical addresses of the second memory on the network for storing a plurality of portions of the program P

including said portion.”

Without conceding the propriety of the asserted combination, however, Applicant respectfully submits that the asserted combination does not disclose at least the aforementioned feature of claim 15, for at least the following reason.

The cited reference does not disclose **a second memory remotely attached to the PVR and coupled to the PVR via a network.**

Again, Browne discloses a standalone PVR with extra storage space within the PVR. Browne does not disclose having additional storage devices remotely attached to the PVR. Amended claim 15 requires the second memory to be an external storage device attached to the PVR.

As for Salmonsen, the Office contends that Salmonsen discloses remote storage 1444 to save television programs. A review of Salmonsen reveals, however, that the “remote storage 144” is merely a source of media content, and not a destination to storage media content (please see paragraph [0183]). Salmonsen is about a system that allows viewing of all types of media contents from various sources, when the viewing system does not support the various formats. Salmonsen has nothing to do with saving or storing television programs, let alone saving portions of a programs in separate memory devices as claimed.

As for Boyle, the Office contends that Boyle discloses a PVR with two memory devices, and a VSM to manage multiple memory locations. A review of Boyle reveals, however, that Boyle merely discloses a hard drive with one or more magnetic discs. Boyle fails to disclose an external second memory as claimed. Also, Boyle fails to disclose any type of VSM. The portion of text (col. 6, lines 38-58; col. 10, lines 31-42, col. 13, line 50-58) the Office pointed out merely relates to accessing particular frames of a video using TrickPlay. Trickplay is not related to retrieving and playing back portions of the same television program stored in different memory locations.

Lastly, regarding Utsunomiya, the Office contends that Utsunomiya teaches storing a portion of the program P in the second memory.

Utsunomiya teaches a plurality of players connected to a network, and having a program to organize sequential playing of these players. Referring to paragraphs [0043], [0077], [0080], [0092-0094] of Utsunomiya, both players 3 and 4, each has a disk 18 for recording and playing. A content that is recorded in both players 3 and 4 are played by players 3 and 4 in an almost-continuous manner by having sequential playing instructions for players 3 and 4. In the claimed subject matter, however, the second portion is retrieved from the remote second memory external to the PVR, and then played by the PVR. Therefore, Utsunomiya fails to disclose a second memory as claimed.

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claim 15 under 35 U.S.C. § 103 are respectfully requested.

Accordingly, the currently amended claim 15 is patentable over the cited references. Thus, dependent claims 16-18, 27 depending thereupon are also patentable.

### **Rejection to Claim 19**

Claim 19 now requires that separate memory devices are located physically separate from each other on the network, and playing back a second portion that is stored on one of the separate memory devices that is located physically separate from the PVR, by using a player in the PVR.

As discussed above, none of the cited prior art teaches this. Utsunomiya merely teaches multiple players playing consecutively.

Accordingly, for at least the aforementioned reasons, reconsideration and withdrawal of the rejection of claim 19 under 35 U.S.C. § 103 is respectfully requested.

Accordingly, the currently amended claim 19 is patentable over the cited references. Thus, dependent claims 20, 28 depending thereupon are also patentable.

### **Rejection to Claims 21-24**

Claims 21-24 were rejected under 35 U.S.C. § 103(a) as being obvious over Browne (WO 92/22983) in view of Salmonsen (U.S. Patent No. 4,891,476) in view of Boyle (U.S. Patent

6,453,115) in view of Utsunomiya et al. (U.S. Patent App. Pub. 2002/0066113), and further in view of Perinpanathan (US 2002/0083145). The applicant respectfully disagrees for the reasons discussed below.

Arguments discussed above regarding the Browne/Salmonsen/Boyle/Utsunomiya combination also apply here.

Accordingly, for at least the aforementioned reasons, reconsideration and withdrawal of the rejections of claim 21-24 under 35 U.S.C. § 103 are respectfully requested.

**Request For Allowance**

Claims 1-24 are pending in this application. The applicant expresses his gratitude to the Examiner for the courtesies extended to Applicant's undersigned representative throughout the long prosecution of this application. The Examiner is invited to contact the below signed representative, should she believe a telephone interview might help to expedite prosecution. In view of the foregoing, Applicant respectfully submits that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested. Favorable consideration is respectfully requested.

Respectfully submitted,  
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